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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/311,996	05/14/99	VAISBERG	E 19681-4
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022434
BEYER WEAVER & THOMAS LLP
P.O. BOX 778
BERKELEY CA 94704-0778

HM22/1002

EXAMINER

SHEINBERG, M

ART UNIT

PAPER NUMBER

1631

DATE MAILED:

10/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/311,996

Applicant(s)

VAISBERG ET AL.

Examiner

Monika B. Sheinberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-61 and 63-65 is/are rejected.
- 7) ☐ Claim(s) 62 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No. 2 sheets.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment PTO-948

DETAILED ACTION

Drawings Notice

Applicant is hereby notified that the required timing for the correction of drawings has changed. See the last 6 lines on the sheet which is attached entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)". It is noted that a PTO Form 948 was mailed with Paper No. 3 on September 29, 2000. Due to the above notification Applicant is required to submit drawing corrections within the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

Information Disclosure Statement

The reference C1 of the information disclosure statement filed March 26, 2001, fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because there is a lack of a publication date. The print-out date is insufficient and does not qualify as a publication date. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. The reference O of the information disclosure statement filed January 19, 2001, fails comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it was not found to be provided in the application.

Response to Amendment B

Applicants' arguments, filed July 16, 2001, have been fully considered by they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office

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actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 49, 50, 56, 57, 59-61, and 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biodx (WO 97/45730, 12/4/97) in view of Weaver et al. (US Pat No 4989301, 9/25/90). Claims 49, 50, 56, 57, 59-61, and 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biodx in view of Singhvi et al. (US pat No 5776748, 7/7/98). Claims 49-61 and 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biodx in view of

Weaver et al. or Biodx and Singhvi as applied to claims 1-6 and 8-10, and in further view of Pauwels (J. Pharm.& Tox. Methods, 1997).

The rejection is maintained and reiterated from the previous office action mailed February 14, 2001, and as necessitated by amendment regarding the added new claims. Applicants argue that the gathered references do not teach or suggest any methods for data comparisons between experiments, however data comparison as such was not within the claims. An intentions of the applicants could be the argued comparison to be the "combining features" practice of claim 49, line 17; or the "analyzing the first and second descriptors" of claim 56, however there does not appear to be any comparing data occurring in this combining event. Thus the argument of the references lacking data comparison is moot due to the lack of data comparison within the claims.

Applicants also argue that the gathered references do not teach or suggest any methods for creating "footprints" that quantify and/or qualify the data. However, the claims, including the above listed new claims, only contain a generic analysis of the data attained by the determined property of manipulation, and not a specific analysis. Thus argument concerning the quantification/qualification of data is moot.

Therefore, the arguments are non-persuasive to overcome the rejection.

Claim Objections

Claim 62 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Inquiries

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242, or (703) 308-4028.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monika B. Sheinberg, whose telephone number is (703) 306-0511. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703) 305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

September 30, 2001

Monika B. Sheinberg
Patent Examiner
Art Unit 1631

MB

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER